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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,234	07/21/2003	Stephen Ritland	53693-11001	7545
23337	7590	11/12/2008	EXAMINER	
HOLME ROBERTS & OWEN LLP			COMSTOCK, DAVID C	
1700 LINCOLN STREET, SUITE 4100				
DENVER, CO 80203			ART UNIT	PAPER NUMBER
			3733	
			MAIL DATE	DELIVERY MODE
			11/12/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/624,234	RITLAND, STEPHEN	
	<b>Examiner</b>	<b>Art Unit</b>	
	DAVID COMSTOCK	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 October 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9, 11-20 and 26-35 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-9, 11-20 and 26-35 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 21 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Allowable Subject Matter***

The indicated allowability of claims 12-20, 26-29, 31-33 and 35 as well as the conditional allowability of the subject matter of claim 10 (which has been incorporated into claim 1) is withdrawn in view of the newly discovered reference(s) to Grimm et al. (US 2004/0172044 A1). Accordingly, the finality of the Office action mailed 25 July 2008 is withdrawn. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-20 and 26-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Grimm et al. (US 2004/0172044 A1), or alternatively, under 35 U.S.C. 103(a) as being unpatentable over Grimm et al.

Grimm et al. disclose a device 20 comprising a surgical image tracker, e.g., 114, a bone screw, e.g., 22, and a body, e.g., 36 and 44 (see, e.g., Figs. 1-5). The body comprises a first aperture, e.g., 48, and a second aperture, e.g., 50, and a passageway therebetween. The apertures are sized to receive the bone screw. The body comprises an attachment point, e.g., the surfaces of slot 94 and/or, e.g., portion 110, when considered part of the body by virtue of assembly together therewith (in which case, portion 110 can be considered a mounting post). It is also noted that other embodiments teach image tracker mounting arrangements that would also include features that can be considered to comprise the claimed features, including the mounting post (see, e.g., Fig. 8). The device comprises set screws, e.g., 62. An inner flange is defined by the body surrounding and extending above aperture 50. Stabilizing projections or pins, e.g., the screws which pass through holes 102, 104, 106 and 108, are removably positioned to extend from a bottom surface of the body. The apertures can be seen as being located on the top, bottom, and/or sides of the body depending on the orientation of the body. Even if the location of the apertures were not considered to be located at the claimed positions by virtue of the particular orientation of the body, it would have been obvious to have located the apertures at the various locations including the top, bottom, and/or sides of the device, for example, to provide mounting options to address individual anatomical or surgical requirements, since it has been held that mere relocation of the features of an invention involves only routine skill in the art.

*In re Japikse*, 86 USPQ 70.

***Response to Arguments***

Applicant's arguments filed 16 October 2008 have been considered but are moot in view of the new ground(s) of rejection set forth above.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710 (a detailed message should be left if Examiner is unavailable). If attempts to reach the Examiner by telephone or voicemail are unsuccessful, the examiner's supervisor, Eduardo Robert, can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733

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